
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/692,913
Filed: October 24, 2003
Inventors:
Ray Y. Lai

Title: System and Method for
Integration of Web Services

§ Examiner: Ingberg, Todd D.
§ Group/Art Unit: 2193
§ Atty. Dkt. No: 5681-66303
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PETITION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted as a petition under 37 CFR 1.144 from the restriction requirement stated in the Office Action dated May 2, 2007.

In the Office Action dated May 2, 2007, the Examiner presented a restriction requirement requiring election of one of seven enumerated inventions. Applicant subsequently elected Invention I (as enumerated by the Examiner) with traverse and presented reasons for traversal in the response filed July 3, 2007. In the Action dated July 30, 2007, the Examiner responded to Applicant's timely traversal, but missed Applicant's election and thus asserted that Applicant's reply was not fully responsive. In a reply filed on August 30, 2007, Applicant pointed out this oversight to the Examiner, who acknowledged the mistake in the Action dated November 26, 2007. However, the Examiner made the restriction requirement final by maintaining the requirement. Applicant hereby petitions for withdrawal of the restriction requirement for at least the following reasons.

The Examiner required restriction to one of the following inventions as defined by the Examiner:

- I. Claims 1-17, drawn to ... code generation ..., classified in class 717, subclass 106.
- II. Claims 18-30 and 82-92, drawn to, identification of use cases..., classified in class 717, subclass 123.
- III. Claims 31-41, drawn to, achieving “interoperability” common look and feel ..., classified in class 717, subclass 109.
- IV. Claims 42-44, drawn to, an OO-CASE tool, classified in class 717, subclass 100.
- V. Claims 45-57, drawn to, generating use cases for architectural modeling, classified in class 717, subclass 104.
- VI. Claims 58-68, drawn to, organizing according to tiers, classified in class 717, subclass 120.
- VII. Claims 69-81, drawn to, component based modeling..., classified in class 717, subclass 107.

Applicant traverses the restriction requirement on the grounds that the Examiner has failed to state a proper requirement for restriction under 35 U.S.C. § 121, as explained below.

As a basis for requiring restriction, the Examiner contends that Inventions I-VII are related as subcombinations disclosed as usable together in a single combination. For the Examiner’s contention to be correct, Applicant’s specification would have to disclose seven non-overlapping (i.e., mutually exclusive) subcombinations, each corresponding to one of the inventions enumerated by the Examiner, where all seven subcombinations are useable together in a single described combination. However, Applicant’s specification clearly does not describe Inventions I-VII as *non-overlapping subcombinations* usable together in a *single combination*. For example, embodiments of the method of claim 45 (Invention V) can clearly be carried out on embodiments of the system of claim 1

(Invention I). Embodiments of claims 45 and I are clearly not described in Applicant's disclosure as separate subcombinations usable together in a single combination. Likewise, embodiments of the medium of claim 69 (Invention VII) could clearly be included in the system of claim 1 (Invention I) and/or implement the method of claim 45 (Invention V). Similarly, as is clear from the specification, the systems of claims 1 (Invention I) and claim 18 (Invention II) may both be used to generate an integrated web service architecture. These claims do not recite separate, non-overlapping subcombinations usable together in a single combination. As another example, the method of claim 58 (Invention VI) can clearly be carried out of the system of claim 18 (Invention II). Numerous other examples of overlap between all of the claim groups are readily apparent from a simple comparison of the claims and from reading Applicant's specification. A difference in terminology or scope between claims does not mean that the claims are limited to separate non-overlapping and mutually exclusive subcombinations. Although the various claim groups enumerated by the Examiner may certainly vary in scope from one another, they also overlap in scope. Thus, the Examiner has clearly mischaracterized Applicant's claims as requiring separate subcombinations usable together in a single combination. Therefore, the restriction requirement is improper.

A proper restriction requirement under M.P.E.P. 806.05(d) requires that the subcombinations **"do not overlap in scope"**. *See, also*, M.P.E.P. 806.05(j) which equates the requirement of "do not overlap in scope" with "mutually exclusive." Subcombinations are separate components of a combination. In other words, subcombinations usable together in a single combination are two non-overlapping and mutually exclusive components of a larger combination. For example, a claim to a seat bracket and a claim to a gear mechanism could be two separate subcombinations usable together in a bicycle combination. In regard to the present application, as discussed above, there is clearly overlap in scope between the claim groups enumerated by the Examiner. Applicant is by no means asserting that the claim groups are identical in scope. In fact there are clearly differences in scope between various ones of the claim groups. However, there is also some overlap in scope between the various claim groups.

The claim groups enumerated by the Examiner cover similar systems and methods overlapping in scope, not separate subcombinations. Since the claim groups have some overlap in scope, restriction cannot be required under M.P.E.P. 806.05(d). Therefore, the Examiner's restriction requirement is improper and must be withdrawn.

Furthermore, according to M.P.E.P. 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, "[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, M.P.E.P. 806.05(d) also states that "the burden is on the Examiner" to make this showing. In regard to this requirement, the Examiner merely states: "Each respective invention has utility as in a system not having the other." This broad and conclusory statement by the Examiner does nothing to show a specific example for each invention of a utility other than in the disclosed combination. Just because one subcombination could be used without another does not establish a utility other than in the disclosed combination. Moreover, simply saying that each alleged subcombination has a separate utility without the others does not provide an actual example of such a utility. The Examiner is required to give a specific example of a utility other than in the disclosed combination for each subcombination. Thus, for the present restriction requirement to be proper, the Examiner would have to provide a real example of a separate utility for each of the seven alleged subcombinations, each separate utility being different from the disclosed combination. The Examiner has clearly not met this burden. Applicant also notes that, by definition, subcombinations will always have different utility *with respect to one another* by their very nature of being separate and distinct non-overlapping components of a larger system (combination). The requirement of M.P.E.P. 806.05(d) is that a subcombination have a "utility *other than in the disclosed combination*." All the examples given by the Examiner clearly apply to the same overall combination as disclosed in the specification and are not examples of utilities *other than in the disclosed combination*. Therefore, the Examiner has not stated a proper restriction requirement.

A third shortcoming of the Examiner's restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show "reasons why there would be a serious burden on the examiner if restriction is not required". **The Examiner completely failed to address this requirement.** Since the Examiner's has not established a "serious burden on the examiner if restriction is not required", Applicant asserts that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner's restriction requirement must be withdrawn.

The Examiner's response to Applicant's traversal in the Action dated July 30, 2007, fails to overcome Applicant's above arguments. The Examiner states that "Applicant's argument hinge on the Applicant's argument that the restriction requires 'mutually exclusive' inventions." However, Applicant's traversal does not "hinge" on just this argument. To the contrary, Applicant also argued that the Examiner did not show, by way of example, that each of the subcombinations has utility other than in the disclosed combination, as is required by M.P.E.P. 806.05(d). Applicant also argued that the Examiner did not show "reasons why there would be a serious burden on the examiner if restriction is not required" as is required by M.P.E.P. § 808.

Furthermore, the Examiner is incorrect in his assertion that there is no "mutually exclusive" or "non-overlapping" requirement for subcombinations under M.P.E.P. 806.05(d). A proper restriction requirement under M.P.E.P. 806.05(d) requires that the subcombinations **"do not overlap in scope"**. *See, also*, M.P.E.P. 806.05(j) **which equates the requirement of "do not overlap in scope" with "mutually exclusive."** Subcombinations are separate, non-overlapping components of a combination. In other words, subcombinations usable together in a single combination are two non-overlapping and mutually exclusive components of a larger combination. For example, a claim to a seat bracket and a claim to a gear mechanism could be two separate subcombinations usable together in a bicycle combination. The seat bracket and the gear mechanism would be two non-overlapping (i.e., mutually exclusive) parts (i.e., subcombinations) of the bicycle, where the bicycle is a "combination" of its parts (subcombinations). The

Examiner has clearly misapplied the concept of “subcombinations disclosed as usable together in a single combination” to Applicant’s claims per M.P.E.P. 806.05(d). For this reason, and the other reasons stated above, withdrawal of the restriction requirement is respectfully requested.

CONCLUSION

In light of the above remarks, Applicant requests that the restriction requirement be withdrawn.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5681-66303/RCK.

Respectfully submitted,

/Robert C. Kowert/

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Date: April 14, 2008